

REMARKS

Applicant appreciates the Examiner's thorough consideration provided the present application. Claims 1, 7-9, 11, 12, 14-16, 23-25, 27-29, 36, 37, 40, 44 and 45 are now present in the application. Claims 1, 11, 14 and 29 have been amended. Claims 10, 13, 38 and 39 have been cancelled. Claims 1 and 29 are independent. Reconsideration of this application, as amended, is respectfully requested.

Claim Objections

Claims 1 and 29 have been objected to due to the presence of minor informalities. In view of the foregoing amendments, in which the Examiner's helpful suggestions have been followed, it is respectfully submitted that this objection has been addressed. Reconsideration and withdrawal of this objection are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 7-14, 27, 29, 36, 37, 40 and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reber, U.S. Patent No. 6,110,748, in view of Gordon, U.S. Patent No. 5,892,577. Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reber in view of Gordon, and further in view of Dermers, WO 98/12599. Claims 23-25, 28, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reber in view of Gordon, and further in view of Ekin, Clinical Chemistry, Vol. 37, no 11, pp. 1955-1967. Claims 38 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reber in view of Gordon, and further in view of Virtanen, U.S. Patent No. 6,342,349. These rejections are respectfully traversed.

In light of the foregoing amendments to the claims, Applicant respectfully submits that these rejections have been obviated and/or rendered moot. As the Examiner will note, independent claim 1 and 29 have been amended.

Claim 1 recites “the means for rotating and the means for displacing being simultaneously directly connected to the member, the member being simultaneously rotatable and displaceable along a radius of the rotation of the member”, “scanning control means for controlling the scanning means for scanning the specimen along the non-linear curve”, “storage means for storing detector signals relating to the marked objects provided by the detector and corresponding position signals provided by the scanning control means”, “means for retrieving the position signals stored in the storage means”, “a microscope for optical inspection of the marked objects” and “the scanning control means are adapted to place the microscope at the position of the marked objects”.

Claim 29 recites “the member being simultaneously rotatable and displaceable along a radius of the rotation of the member”, “storing detector signals relating to the object provided by the detector and corresponding position signals provided by the scanning control means”, “retrieving the position signals stored in the storage means”, “placing a microscope at the position of the object” and “optically inspecting the object by the microscope”.

Applicant respectfully submits that the above combinations of elements and steps as set forth in amended independent claim 1 and 29 are not disclosed nor suggested by the references relied on by the Examiner.

The Examiner alleged that Reber in col. 4, lines 18-24 teaches a positioning mechanism 34 directly connected to the device 20 and the positioning mechanism 34

comprises both a translational positioning mechanism and a rotary positioning mechanism simultaneously directly connected to the member. Applicant respectfully disagrees. Reber merely teaches that the positioning mechanism 42 can include a rotary positioning mechanism such as a spindle/turntable, and/or a translational positioning mechanism such as a conveyor (see col. 4, lines 21-23). Reber fails to teach how the positioning mechanism 42 works with the device 20 and nowhere teaches that the spindle/turntable and the conveyor are simultaneously directly connected to the device 20. As well known in the art, the conveyor (or the tray) of the CD-ROM drive is used to deliver the disc to the CD-ROM drive. After delivery, the disc is fixed on and rotated by the spindle/turntable. However, during the rotation of the disc, the conveyor or the tray will not move the disc because it would cause the malfunction of the disc drive or damage the disc. Therefore, the spindle/turntable and the conveyor will not simultaneously work with the disc.

The Examiner also alleged that Reber in col. 9, lines 37-40 and FIG. 12 discloses “the member being simultaneously rotatable and displaceable along a radius of the rotation of the member” as recited in claims 1 and 29. Again, Applicant respectfully disagrees. Reber in col. 9, lines 37-40 merely discloses that the step of positioning of the device 20 and the data reader 34 can include translating the device 20, rotating the device 20, translating the data reader 34, and/or rotating the data reader 34. Reber nowhere teaches that translating the device 20 and rotating the device 20 will occur simultaneously. In fact, Reber discloses “[f]or disk-shaped embodiments of the device 20, the step of positioning preferably includes rotating the device 20 and radially translating a head of the data reader 34” (see col. 9, lines 40-43). Although Reber in FIG. 12 discloses a spiral

lattice, it still fails to teach simultaneously translating the device 20 and rotating the device 20. In fact, according to Reber's embodiment mentioned above, the spiral lattice will be read by rotating the device 20 and radially translating a head of the data reader 34, not by simultaneously translating and rotating the device 20. Accordingly, Reber fails to teach "the member being simultaneously rotatable and displaceable along a radius of the rotation of the member" as recited in claims 1 and 29.

Gordon also fails to cure the deficiencies of Reber. As shown in FIG. 1 of Gordon, the disc 1 is mounted on the rotatable shaft 6 and is read by the optical block 7, which is moveable along a linear track (see also col. 5, lines 24-27). Again, the disc 1 is read by rotating the disc 1 via the rotatable shaft 6 and translating the optical block 7, not by simultaneously rotating and translating the disc 1.

Reber and Gordon also fail to teach "a microscope for optical inspection of the marked objects" and "the scanning control means are adapted to place the microscope at the position of the marked objects" as recited in claim 1 and "placing a microscope at the position of the object" and "optically inspecting the object by the microscope" as recited in claim 29.

With regard to the Examiner's reliance on Virtanen, Virtanen in col. 48, lines 41-48 discloses "optical disk readers are, in essence, scanning confocal laser microscopes" and "they can be used, with proper software, to study the detailed structure of biological and other specimens". Applicant respectfully submits that Virtanen fails to disclose how "proper software" should be constructed nor are there any references disclosing how the skilled person should solve the problem of designing "proper software". In fact, Virtanen only discloses using the optical disk reader as a microscope.

Virtanen's disclosure at best is solely a desideratum, not a solution guiding the skilled person to achieve the claimed invention. Accordingly, the non-enabling disclosure of Virtanen is not a proper reference against the present patent application with respect to use of microscopes.

Applicant also respectfully submits that none of the utilized references teach or suggest "scanning control means for controlling the scanning means for scanning the specimen along the non-linear curve", "storage means for storing detector signals relating to the marked objects provided by the detector and corresponding position signals provided by the scanning control means" and "means for retrieving the position signals stored in the storage means" as recited in claim 1 and "storing detector signals relating to the object provided by the detector and corresponding position signals provided by the scanning control means" and "retrieving the position signals stored in the storage means" as recited in claim 29.

With regard to the Examiner's reliance on Dermers and Ekin, these references have only been relied on for their teachings related to the dependent claims of the present invention. These references also fail to disclose the above combination of the elements and steps as set forth in amended independent claims 1 and 29. Accordingly, these references fail to cure the deficiencies of Reber, Gordon or Virtanen.

Accordingly, none of those references individually or in combination teach or suggest the limitations of amended independent claims 1 and 29. Therefore, Applicant respectfully submits that claims 1 and 29 and their dependent claims clearly define over the teachings of the references relied on by the Examiner.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are respectfully requested.

CONCLUSION

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

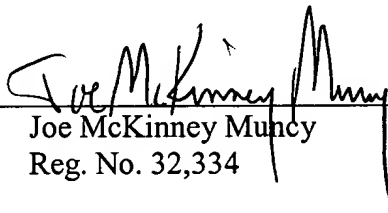
In the event there are any matters remaining in this application, the Examiner is invited to contact Joe McKinney Muncy, Registration No. 32,334 at (703) 205-8000 in the Washington, D.C. area.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant respectfully petitions for a one (1) month extension of time for filing a response in connection with the present application and the required fee of \$120.00 is attached herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Joe McKinney Muncy
Reg. No. 32,334

KM/GH/mmi
2836-0153PUS1

P. O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000